



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,397	02/13/2004	Naoki Shindo	199372003910	2798
25224 7590 06/23/2010 MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024				
EXAMINER				
MARKOFF, ALEXANDER				
ART UNIT		PAPER NUMBER		
1711				
MAIL DATE		DELIVERY MODE		
06/23/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,397

Applicant(s)

SHINDO ET AL.

Examiner

Alexander Markoff

Art Unit

1711

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-14, 16, 18, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14, 16, 18, 30, and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/21/10 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 12-14, 16, 18, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshima et al (US Patent No 6,613,692).

Toshima et al teach a method as claimed except for the specific recitation of the step of generating of a solvent vapor with fluid communication of between the solvent vapor generator and the processing container being disconnected. See entire document, especially Figures 6, 11, 12, 14, 16, 17, 20, 21, and 35 the related description and the description at columns 8, 10-11, 15-16, 23-26 column 33, lines 56-67.

However, Toshima et al teaches a valve (179, on Figure 11, 375 on Figure, 376 on Figure 35) between the vapor generator and the processing vessel.

It would have been obvious to an ordinary artisan to keep the valve (376,375) between the vapor generator and the processing vessel shut until the steam generator is at working conditions to ensure the proper operation of the equipment.

It is also noted that Toshima et al teach maintaining the pressure in the processing vessel at 196 kPa, which is above the atmospheric pressure.

The proper pressure in the vapor generator is maintained by the maintaining the required temperature.

It would have been obvious to an ordinary artisan at the time the invention was made that the pressure in the vapor generator is maintained above the pressure of the processing vessel to enable the intended operation of the equipment and to deliver the vapor into the processing vessel.

It would also have been obvious to an ordinary artisan at the time the invention was made to open the valve (179, 375, 376) only when the pressure in the vapor generator is above of the pressure in the processing vessel to enable the intended operation of the equipment and to deliver the vapor into the processing vessel and to prevent the flow of the processing fluids from the processing vessel into the vapor generator.

As to claim 30:

This claim requires the use of a pressure sensor. Toshima et al do not specifically teach the use of a pressure sensor on the vapor generator.

However, it would have been obvious to an ordinary artisan at the time the invention was made to provide the vapor generator of Toshima et al with a pressure sensor and used it to further control the generator and to ensure the safe operation of the generator, because it was notoriously well-known in the art to provide the devices, which are operated under the pressure with a pressure sensors to regulate and monitor the work of the devices.

Response to Arguments

6. Applicant's arguments filed 5/21/10 have been fully considered but they are not persuasive.

The applicants again argue that since they filed the certified translation of the foreign priority application and still Toshima et al (US Patent No 6,613,692) is qualified only under 35 USC 102 (e) for the purpose of the rejection under 35 USC 103(a). The applicants argue that since the present application and Toshima et al at the time of the present application were both assigned or subject to be assigned to the same assignee, Toshima et al is not available as a prior art for purposes of any rejection under 35 UCS 103(a).

This is not found persuasive.

The applicants have not provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Toshima et al at the time this invention was made, or was subject to a joint research agreement at the time this invention was made.

A statement that the present application and Toshima et al at the time of the present application were both assigned or subject to be assigned to the same assignee is not sufficient to disqualify the document as the prior art.

The applicants have not provided a proper statement, which evidences that the invention was owned by, or subject to an obligation of assignment to, the same entity as Toshima et al at the time this invention was made, or was subject to a joint research agreement at the time this invention was made.

The rejection over Toshima et al (US Patent No 6,613,692) is maintained.

7. The rejection over Toshima et al (DE 10036867) is withdrawn in view of filing the certified translation of the priority documents.
8. The rejection over Kamikawa et al is withdrawn in view of the amendments made.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/779,397
Art Unit: 1711

Page 7

Alexander Markoff
Primary Examiner
Art Unit 1711

/Alexander Markoff/
Primary Examiner, Art Unit 1711